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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
85804-015401

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on May 5, 2006

Signature

Suzanne Marx

Typed or printed
name Suzanne Marx

Application Number
10/783,862

Filed
February 20, 2004

First Named Inventor
Kevin Ellis

Art Unit
2165

Examiner
Hassan Mahmoudi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 39,000

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Carole A. Quinn
Signature

Carole A. Quinn

Typed or printed name

(714) 708-6500

Telephone number

May 5, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of three forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	10/783,862	Group Art Unit:	2165
Applicant(s):	Kevin Ellis	Examiner:	Hassan Mahmoudi
Filing Date:	February 20, 2004	Docket No.	85804-015401
Title: A SYSTEM AND METHOD FOR PROVIDING AN IMPROVED GRAPHICAL USER INTERFACE FOR SEARCH		Customer No.	32361

CERTIFICATE UNDER 37 CFR 1.6(d)

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Suzanne Marx
Name: Suzanne Marx

**LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This paper is being filed with a Request For Pre-Appeal Brief Review, a Notice of Appeal, and a Petition For Extension Of Time for one month from April 5, 2006 to May 5, 2006.

Applicant seeks formal review by a panel of examiners of the 35 U.S.C. § 103(a) rejection of the pending claims, i.e., Claims 1 to 27, which was made final in an Office Action mailed January 5, 2006 (hereinafter referred to as the "current Office Action"). Claims 1 to 27 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2003/0061211 (Shultz) and U.S. Publication No. 2002/0065671 (Goerz). It is submitted that the § 103(a) rejection is both factually and legally deficient, and that withdrawal of the rejection is therefore appropriate. The remarks made herein supplement Applicant's remarks of record in the instant case.

Turning first to Claim 1, a system is recited for providing an improved graphical user interface for web search, the graphical user interface comprising a search region containing a user's search criteria, a result region comprising indicia of a plurality of search categories, and a connection indicator that establishes a visual connection between the search region and a selected

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one of search category indicia so as to enable a user to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by the connection indicator.

Neither Shultz nor Goerz, alone or in hypothetical combination (if such a combination is even permissible, which Applicant in no way concedes) teach, suggest or disclose the claimed invention.

As discussed at pages 10 to 12 of Applicant's Response dated October 11, 2006, Shultz fails to teach, suggest or disclose a result region comprising indicia of a plurality of search categories. The Office Action cites to paragraphs 73 to 79 of Shultz, however, the cited portions describe a portion of a user interface (textual portion 440) in which a user can view categories of information associated with search results (Schultz Fig. 4). This cannot be said to be the same as indicia of a plurality of search categories, and/or a result region which includes the indicia of a plurality of search categories. By way of non-limiting example of one embodiment of the claimed invention, see Fig. 4 of the instant application which depicts the visual display of a connection indicator 110 between a selected search category indicia 90 (e.g. web, selected from categories such as web, images, news, etc.) and a search region 130 where search criteria can be entered by a user, thereby visually establishing that a search term entered in the search region 130 will be searched in the search category "web".

Further, Shultz fails to teach, suggest or disclose a connection indicator establishing a visual connection between a search region and a selected one of the search category indicia. The Office Action cites to paragraphs 66 and 70 of Shultz. Paragraph 66 of Shultz simply describes a database, as shown in Figure 3 of Shultz, of textual information, which cannot be said to be the same as a graphical user interface including a connection indicator establishing a visual connection between a search region of the graphical user interface and a selected one of a plurality of search categories of a result region of the graphical user interface.

Paragraph 70 of Shultz describes that a user using a displayed area map to specify a geographic area as a search term using a mouse as a pointer (See Shultz Fig. 4). However, allowing a user to specify a geographic area as a search term cannot be said to be the same as a graphical user interface comprising a connection indicator establishing a visual connection between a search region of the graphical user interface and a search category indicia selected from indicia of a plurality of search categories of a result region of the graphical user interface.

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Applicant has pointed out, and the Examiner does not disagree, that Goerz also fails to teach, suggest or disclose at least the above features. (See Applicant's Response dated October 11, 2006 at pages 12 to 14 and the Examiner response at pages 7 and 8 of the current Office Action.) The cited portions of Goerz fail to even mention a connection indicator, a connection indicator indicating a particular search category, and/or a connection indicator enabling a user to make a cognitive connection indicating that the user's search criteria was found in a particular search category.

Accordingly, since Shultz is missing multiple elements of the claim, and Goerz is missing (at least) the same multiple elements of the claim, these two references simply cannot form the basis of a satisfactory obviousness rejection, and certainly neither reference can be relied upon as an anticipatory reference.

The above noted reasons should be sufficient to withdraw the § 103(a) rejection. Notwithstanding this and as a further basis for withdrawal of the rejection, it is submitted that the Office Action fails to consider the claimed invention as a whole, and indeed improperly dissects the connection indicator claim language, and then applies different references to the dissected language without regard to the significance of the claim language as a whole.

More particularly, Claim 1 recites, in part:

"a connection indicator establishing a visual connection between said search region and a selected one of search category indicia so as to enable the user to make a cognitive connection indicating that the user's search criteria was found in the particular search category indicated by said connection indicator."

It is clear from the claim language that the connection indicator serves to establish a visual connection between a search region and a search category indicia so as to enable the user to make a cognitive connection indicating that the user's search term was searched for in the particular search category indicated by the connection indicator. Since the Office Action concedes that Shultz fails to teach, suggest or disclose an indicator indicating that the user's search criteria was found in a particular search category indicated by the connection indicator, Shultz cannot be said to teach, suggest or disclose the claimed connection indicator.

Notwithstanding the above reasons, and as a further basis for withdrawal of the rejection, it is submitted that the Office Action fails to make the required showing to establish a prima facie case of obviousness under 35 U.S.C. § 103(a) for the further reason that the hypothetical combination suggested in the Office Action cannot be made without a proper showing in the references themselves of a motivation or suggestion to combine. It is firmly established law that

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the motivation or suggestion cannot be drawn from Applicant's own disclosure. But the alleged "motivation" statements made in the Office Action seem to mirror language from Applicant's own Application, and the Office Action fails to identify any other source of the stated motivation. More particularly and at page 3 of the Office Action, the Examiner states:

"[i]t would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Shultz et al by the teaching of Goerz Jr. et al because enabling a user to make [a] cognitive connection indicating that the user's search term was found in the particular search category indicated by the connection indicator, would enable the user to view both the search results and the selected search categories on the same page, making it easier for the user to refine the search criteria while viewing the matched results." (Emphasis added)

Yet page 9 of the present Application states as follows:

"[t]he visual link between the search term 30 contained in the search field 20 and the search category 60 contained within selected tab 90 not only reduces the amount of textual data on the screen, but it also rapidly and intuitively draws the user's attention to the link between what was searched and the category of search from which the results obtained and currently displayed on the screen."

Additionally, page 8 of the present Application contains the following passage:

"[b]y providing the visual connection indicator of the present invention at both the top and bottom of the page, the user need not navigate back to the top of the page to determine the category of search selected, and also which search category can be selected to further conduct or narrow the search." (Emphasis added)

As can be seen from at least the underlined portions above, the Office Action's stated motivation mirrors the discussion of aspects and advantages of the claimed invention, as provided in the present Application. In the absence of the necessary support, and as clearly evidenced from the excerpts taken from the Office Action and Applicant's own disclosure set forth above, it can only be said that Applicant's own disclosure is being used as a blueprint to piece together the Shultz and Goerz references to improperly reject the claims of the present invention.

The applied art, namely Shultz and Goerz, neither alone nor in combination (n.b., such combination is not believed to be permissible at least in view of the lack of a showing of a motivation to combine, as discussed above) teach, suggest or disclose each and every one of the features recited in Claim 1.

In view of the foregoing and for at least the reasons discussed above, Claim 1 (and the claims that depend from Claim 1) is believed to be in condition for allowance. Claims 12 and 23 (and the claims that depend from Claims 12 and 23) are also believed to be in condition for allowance for at least the same reasons.

Furthermore and with regard to dependent Claim 7, Applicant previously pointed out that it is rejected on the same grounds as Claim 1 (see pages 2 and 3 of the Office Action), however

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Claim 7 has the added features of alternate search region, alternate result region and alternate connection indicator. Neither the previous nor current Office Action addresses the additional features of Claim 7, and the current Office Action fails to even mention Applicant's request for clarification of the grounds for rejecting the claim. Moreover, the dependent claims are also not specifically addressed with a full and fair recitation of where each claimed element is found in the prior art.

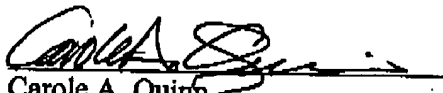
It is submitted that the 35 U.S.C. § 103(a) grounds for rejection are both factually and legally deficient. Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection are therefore respectfully requested.

Applicant's undersigned attorney may be reached by phone in California (Pacific Standard Time) at (714) 708-6500. All correspondence should continue to be directed to the below-listed address.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

Date: May 5, 2006


Carole A. Quinn
Reg. No. 39,000
Email: quinnnc@gtlaw.com
Phone: (714) 708-6500

Customer Number 32361
GREENBERG TRAURIG, LLP
Met Life Building
200 Park Avenue, 20th Floor
New York, New York 10166
Phone: (212) 801-9200
Fax: (212) 801-6400

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